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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/814,066 | 06/21/2001 | Franz Knauseder | 20551/I/JR | 2541 |
| 7055 | 7590 | 12/13/2005 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | SAFAVI, MICHAEL | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3673 | |

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/814,066

Applicant(s)

KNAUSEDER, FRANZ

Examiner

M. Safavi

Art Unit

3673

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 November 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Box 11: Contd. Applicant's remarks from page 4 to page 5 of the response, with respect to meaning of "pre-applied adhesive", are not convincing. Examiner is not aware that the term "pre-applied adhesive" must be taken to specifically define what is disclosed in U.S. patent No. 4,417,028. Applicant's remarks as from the bottom of page 4 to line 15 on page 5 of the response may serve to establish a compliance with definiteness as by explaining the one of ordinary skill in the art would realize that such a term is utilized in the art. However, the term to "pre-applied" does not serve to establish only those adhesives described within U.S. patent No. 4,417,028. As has been set forth throughout prosecution of the instant application the term to pre-applied is taken to set forth an application, (of adhesive in this instance), prior to any other given step or procedure. This is met by the combination of references used against claims 1 and 31. Examiner reasons that the term pre-applied coupled with the term adhesive as used in the art, as by U.S. patent No. 4,417,028, is meant to characterize the adhesive as "applied off-site" or applied "prior to the time of assembly" or "preapplied at the factory" and not otherwise to any specific type of adhesive. Thus, as broadly accepted, the term to "pre-applied adhesive" is met by the combination of references used against claims 1 and 31 since the adhesive applied to the modified Austrian '560 reference is applied prior to actual joining of the members as well as prior to the actual final assemblage of the cladding members to form a substrate, (though this is not relevant since claims 1, 31, and 34 merely set forth an adhesive upon a joint end of a cladding board which is what the modified Austrian '560 reference discloses, *In re Fessman*, 489 F.2d 742, 180

U.S.P.Q. 324 (CCPA 1974) and *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985).

Applicant's prosecution of the instant application would seem to verify Examiner's interpretation of the term to "pre-applied adhesive". For example, Applicant within the latest amendment to the claims has added an independent claim 34 which recites "a *pre-applied first layer* arranged on at least one surface of the groove at least in an area of the divergent sides and a *pre-applied second layer* arranged on at least one surface of the tongue at least in an area of the divergent wedge shape, *wherein each of the pre-applied first and second layers comprises an adhesive layer* or a pre-applied layer of a substance which activates an adhesive. With such claim recitation Applicant is apparently addressing the question of whether or not the adhesive is applied prior to a subsequent step or procedure and not the particular adhesive itself. In other words, Applicant is using "pre-applied" as a modifier to establish *when* a substance has been applied, not *what* substance has been applied. Further, at page 16 in Applicant's response of June 24, 2005 Applicant argues that "Roesch does not disclose or suggest a pre-applied adhesive layer...much less, [adhesives]...which are applied off-site." Clearly, Applicant's argument is directed to when or where the adhesive is applied and not what type of adhesive is applied.

As for Roesch not being analogous art, one of ordinary skill in the art would look to the adhesive subject matter of Roesch when attempting to establish an appropriate adhesive for glued joints. Indeed, Roesch deals with one member fitting within another.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Safavi whose telephone number is (571) 272-7046. The examiner can normally be reached on Mon.-Thur., 8:30-5:00.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**MICHAEL SAFAVI
PRIMARY EXAMINER
ART UNIT 354**

M. Safavi
December 05, 2005